

ESTTA Tracking number: **ESTTA423161**

Filing date: **08/03/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Ugglebo Clogs LLC		
Entity	Limited Liability Company	Citizenship	Minnesota
Address	11130 Lake Point Drive Chisago City, MN 55013 UNITED STATES		

Attorney information	Andrew B. Katz Belles Katz LLC 721 Dresher Road, Suite 1100 Horsham, PA 19044 UNITED STATES akatz@belleskatz.com, DVandenburg@CCVL.com, JWinkels@CCVL.com Phone:215 658 1890
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Applicant Information

Application No	77969845	Publication date	07/26/2011
Opposition Filing Date	08/03/2011	Opposition Period Ends	08/25/2011
Applicant	Deckers Outdoor Corporation 495-A S. Fairview Avenue Goleta, CA 93117 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: footwear; clothing, namely, sweaters, shirts, pants, shorts, skirts, coats, jackets, vests, ponchos, snow suits, scarves, muffs, mittens and gloves; headwear; children's buntings

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77929400	Application Date	02/05/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	UGGLEBO		

Design Mark	UGGLEBO
Description of Mark	NONE
Goods/Services	Class 025. First use: clogs

Related Proceedings	Petition to Cancel No. 92-053594 and U.S.D.Minn Civil Action No. 11-cv-213
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Attachments	77929400#TMSN.jpeg (1 page)(bytes) 77969845Opposition.pdf (6 pages)(170450 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Andrew B. Katz/
Name	Andrew B. Katz
Date	08/03/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No.: 77/969,845

Filed: March 26, 2010

For the mark: UGG (and Design)

Published in the Trademark Official Gazette on July 26, 2011

UGGLEBO CLOGS, LLC,)	
)	
Opposer,)	
v.)	Opposition No. _____
)	
DECKERS OUTDOOR CORPORATION,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Ugglebo Clogs, LLC ("Opposer"), a Minnesota LLC having a principal place of business at 11130 Lake Point Drive, Chisago City, Minnesota 55013, believes that it will be damaged by the registration of the UGG mark shown in Application Serial No. 77/969,845 ("Applicant's Application") in International Class 25 and U.S. Classes 22, 39 and hereby opposes the same.

The grounds for the opposition are as follows:

1. On March, 26, 2010, Deckers Outdoor Corporation, a Delaware corporation with a last known address of 495-A S. Fairview Avenue, Goleta, California, 93117 ("Applicant") filed Applicant's Application to register UGG ("Applicant's Mark") as a trademark for "footwear; clothing, namely, sweaters, shirts, pants, shorts, skirts, coats, jackets, vests, ponchos, snow suits, scarves, muffs, mittens and gloves; headwear; children's buntings" ("Applicant's Goods").
2. Applicant's Mark was published for opposition in the Trademark Official Gazette on July 26, 2011.

3. Opposer is the owner of the mark UGGLEBO, used in connection with men's, women's and children's footwear, namely clogs and clog boots ("Opposer's Goods").

4. Opposer and its predecessors-in-interest began using the mark UGGLEBO in connection with Opposer's Goods in interstate commerce in the United States at least as early as January 1, 1970 and have maintained continuous use of the marks in the United States since that time.

5. Opposer and its predecessors-in-interest have consistently and publicly promoted its inherently distinctive UGGLEBO mark in connection with its offering of Opposer's Goods. As a result, Opposer has developed a favorable reputation and valuable goodwill in the mark UGGLEBO, which identifies, distinguishes and indicates the source of Opposer's Goods.

6. Opposer filed Application No. 77/929,400 for registration of the mark UGGLEBO in connection with clogs in International Class 25 ("Opposer's US Application"). On May 7, 2010, Opposer's US Application was rejected under Section 2(d) of the Lanham Act in light of two of Applicant's registrations, US Registration Nos. 3050925 and 3360442.

7. Opposer petitioned the Trademark Trial and Appeal Board (TTAB) to cancel the two registrations recited in paragraph 6 above as well as three other registrations belonging to Applicant. The Petition to Cancel (Board No. 92-053594) is currently suspended pending the resolution of a civil action in the United States District Court for the District of Minnesota, Ugglebo Clogs LLC v. Deckers Outdoor Corporation, No. 11-cv-213 ("the civil action"). It is understood that any determination made in the civil action would bear upon this Notice of Opposition.

8. On information and belief, Applicant is a Delaware corporation having a principal place of business at 495-A S. Fairview Avenue, Goleta, California, 93117.

9. Upon information and belief, 1978 is the earliest date for which Applicant can establish use of the mark UGG on any of Applicant's Goods.

10. Opposer began using the mark UGGLEBO for Opposer's Goods at least eight years prior to Applicant's alleged date of first use for any of Applicant's Goods and several decades before Applicant's application filing date for Applicant's Mark.

11. Opposer's common law rights in the UGGLEBO mark have priority over Applicant's Mark.

12. Applicant's Mark is highly similar to Opposer's UGGLEBO mark. The letters "U," "G," and "G" are the first three letters of Opposer's UGGLEBO mark and the most distinctive and memorable part of the mark. Many consumers pronounce the "Ugg" in UGGLEBO the same as they pronounce Applicant's Mark, i.e., they say Ugg-le-bo or Uggly-bo.

13. Applicant's Goods overlap with and/or are closely related to Opposer's Goods. Indeed, the prosecution history of Opposer's US Application confirms the confusingly similar relationship between Applicant's Goods and Opposer's Goods as the examiner supported her rejection of Opposer's US Application in light of two of Applicant's registrations, US Registration Nos. 3050925 and 3360442.

14. Applicant's Mark, when used on or in connection with Applicant's Goods, is likely to cause, and in fact have caused, confusion, mistake, and/or deception with Opposer's UGGLEBO mark as used by Opposer in connection with Opposer's Goods. Some consumers are likely to believe that UGGLEBO brand footwear and UGG brand footwear and other of Applicant's Goods bearing the UGG mark are from the same source, or that there is some sponsorship, connection or association between Opposer and Applicant. Other consumers as well as some wholesalers, retailers, and consumers will conclude that Opposer is attempting to

trade on the UGG mark, potentially causing them not to buy UGGLEBO products and diminishing the good will in the UGGLEBO mark. Applicant's use of the UGG mark on Applicant's Goods has diminished and will continue to diminish the value of the UGGLEBO mark.

15. For all the reasons stated above, Applicant's Mark is likely to cause consumer confusion. Therefore, registration of Applicant's Mark should be refused under 15 U.S.C. § 1052(d) and 1063.


WHEREFORE, Opposer prays that Application Serial No. 77/969,845 be rejected, that registration of the mark therein for the goods therein specified be refused, and that the present opposition be sustained.

This Notice of Opposition is hereby filed electronically and the fee also paid electronically. Opposer hereby authorizes the U.S. Patent and Trademark Office ("PTO") to charge PTO Deposit Account No. 503656 if the electronic payment is insufficient for any reason. The undersigned attorney for Applicant is an authorized user of this Deposit Account.

Respectfully submitted,

Dated: August 3, 2011

BELLES KATZ LLC

By 
Andrew B. Katz, USPTO Reg. No. 34,200
721 Dresher Road, Suite 1100
Horsham, Pennsylvania 19044
Telephone: (215) 658-1890
Facsimile: (888) 649-7733
akatz@belleskatz.com

And

CARLSON, CASPERS, VANDENBURGH &
LINDQUIST

Alan G. Carlson
J. Derek Vandenburg
225 South Sixth Street, Suite 3200
Minneapolis, MN 55402
Telephone: (612) 436-9600
Facsimile: (612) 436-9605

COUNSEL FOR OPPOSER
UGGLEBO CLOGS, LLC

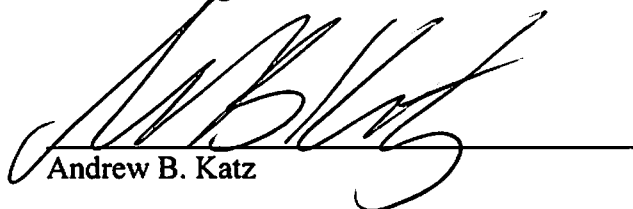
CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 3rd day of August, 2011 a true and correct copy of the foregoing Notice of Opposition (along with this Certificate of Service) was sent by first class mail, postage pre-paid to:

Deckers Outdoor Corporation
495-A S. Fairview Avenue
Goleta, California, 93117

And

Paul G. Juettner, Esq.
Tom Fitzsimons, Esq.
Greer, Burns & Crain, Ltd.
300 S. Wacker Drive Suite 2500
Chicago, Illinois 60606-6771



Andrew B. Katz